

REMARKS / DISCUSSION OF ISSUES

Applicant(s) thank(s) the Examiner for acknowledging the claim for priority and receipt of certified copies of all the priority document(s), and for stating that the submitted drawings are acceptable.

Claims and 1-10 are pending in the application. The claims in general are amended for one or more non-statutory reasons, for example to correct one or more informalities or obvious errors, remove figure label number(s), remove unnecessary limitations, and/or replace European claim phraseology with U.S. claim language having the same meaning. The claims are not narrowed in scope and no new matter is added. Entry after final action is proper because the scope of the claims is not changed and no further searching is required.

The final Office action rejects claims 1, 2, 5-7, 9 and 10 under 35 U.S.C. §102(b) over U.S. Patent Application Publication US 2003/0031026A1 to *Tiesler-Wittig* et al. Applicant(s) respectfully traverse(s) this rejection. Claims 1, 2, 5-7, 9 and 10 are patentable under 35 U.S.C. §102(b) over the cited reference at least because *Tiesler-Wittig* fails to teach or suggest the portion of the surface of the outer bulb facing away from the discharge vessel that is shaped as a negative lens as recited in independent claim 1, and therefore also in claims 2-9 which depend, directly or indirectly, from independent claim 1.

As understood by one of ordinary skill in the art, negative lenses produce virtual images of a light discharge that is a reduced, or negative, version of the light discharge. Conversely, *Tiesler-Wittig* teaches a pair of lenses 30 employed to shift a virtual location of a light discharge 17 radiating from a discharge vessel 16 whereby the light discharge 17 has the same size and shape in FIG. 1 (actual location of light discharge 17 with discharge vessel 16) as in FIG. 1a (virtual location of light

discharge 17 within discharge vessel 16 as shifted the lens 30). See, *Tiesler-Wittig* at paragraphs [0014]-[0022], [0038]-[0040] and [0049]-[0053]. *Tiesler-Wittig* nowhere teaches or suggests a reduction or negative version of light discharge 17 when shifted from its actual location within discharge vessel 16 to a virtual location within discharge vessel 16 by lens 30, and thus there is no basis for concluding, as the final Office action incorrectly asserts, that the lens 30 of *Tiesler-Wittig* must be shaped as a negative lens.

The Examiner acknowledges that the cited reference does not explicitly teach a negative lens, but asserts, as apparent "official notice," that *"in virtually [shifting] the location of the gas discharge, at least a portion of the lens (30) on the outer bulb (20) must be shaped as a negative lens,"* and that therefore the feature of claim 1 missing from the cited reference is "inherently disclosed." Applicant(s) disagree(s) with this assertion, for which the final Office action provides no support other than the bald assertion itself. This assertion is not "capable of instant and unquestionable demonstration as being well known" and therefore must be supported by citation to some reference work recognized as a standard in the pertinent art. **MPEP § 2144.03 A.**

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " **MPEP § 2112 IV.**

The Office has stated that if an applicant challenges a factual assertion as not properly officially noticed or not properly based upon common knowledge, the examiner must support the finding with adequate evidence; i.e. the Examiner must cite a reference in support of that position, or, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). **MPEP § 2144.03 C.**

Since the Office action does not provide any extrinsic evidence or support for its assertion that a virtual shifting must necessarily require the structural feature(s) recited in the claims, nor an affidavit or declaration under 37 CFR 1.104(d)(2), the rejection must be withdrawn.

Accordingly, withdrawal of the §102(b) rejection of claims 1, 2, 5-7, 9 and 10 under 35 U.S.C. §102(b) is respectfully requested.

The final Office action rejects claims 3 and 4 under 35 U.S.C. §103(a) as over U.S. Patent Application Publication US 2003/0031026A1 to *Tiesler-Wittig* et al. Applicant(s) respectfully traverse(s) this rejection. Claims 3 and 4 are patentable over the cited reference at least because they depend, directly or indirectly, from independent claim 1 which is patentable under the statute as explained above. Accordingly, withdrawal of the §103(a) rejection of claims 3 and 4 is respectfully requested.

The final Office action rejects claim 8 under 35 U.S.C. §103(a) over U.S. Patent Application Publication 2003/0031026 A1 to *Tiesler-Wittig* et al. in view of U.S. Patent Application Publication 2004/0156984 A1 to *Vitt* et. al. Applicant(s) respectfully traverse(s) this rejection. Claim 8 is patentable over the cited reference at least because it depends, directly or indirectly, from independent claim 1 which is patentable under the statute as explained above. Accordingly, withdrawal of the §103(a) rejection of claim 8 is respectfully requested.

The Office action rejects claim 1 for double patenting over claim 1 of allowed U.S. Patent Application No. 10/556,003 to *Kruger* et al. As suggested by the Examiner, a Terminal Disclaimer is filed herewith to obviate the double patenting rejection. Accordingly, withdrawal of the rejection of claims is respectfully requested.

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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